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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,150	03/06/2002	Miles R. Jackson	IND10292	9211
22917	7590	07/19/2005	EXAMINER	
MOTOROLA, INC. 1303 EAST ALGONQUIN ROAD IL01/3RD SCHAUMBURG, IL 60196			ZIMMERMAN, BRIAN A	
			ART UNIT	PAPER NUMBER
			2635	

DATE MAILED: 07/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

5m

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/092,150		JACKSON ET AL	
	<b>Examiner</b>		<b>Art Unit</b>	
	Brian A. Zimmerman		2635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 May 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **EXAMINER'S RESPONSE**

### **Status of Application**

In response to the applicant's amendment received on 5/20/05. The examiner has considered the new presentation of claims and applicant arguments in view of the disclosure and the present state of the prior art. And it is the examiner's position that claims 1-23 are unpatentable for the reasons set forth in this office action:

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1-10,12,14,17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Legge (2002/0034978), Lauper (WO 01/69548) and Jigour (5815426).

Legge shows passive (battery-less) RFID device having stored thereon data bits and expiration information that communicates in an inductive manner. See Abstract and paragraphs 22 and 26. Legge shows the transponder to include time criteria and/or credit criteria for providing expiration when the credits or time expires. See paragraphs 41 and 43. Legge additionally shows data bits as providing access only if the device is age appropriate, violence appropriate or height appropriate for rides. See paragraphs 42 and 43. The transponder is programmed at the purchase location, paragraph 29.

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In an analogous art, Lauper shows a RFID card can be used as an admission ticket or a SIM card for a mobile telephone. See page 1 lines 7-20 and page 6 lines 10-28:

Chip-card terminals are used more and more often as identification means for different systems and as portable data storage means with data processing abilities. Among others, it is known that chip-cards can be used as electronic money wallet enabling payment at different points of sale. Conceivable applications for chip-cards as electronic money wallets comprise, among others, food retail stores, department stores, utilization of parking space, public transportation means, personal transportation means (taxis), service stations, hotels and restaurants, canteens and refectories, automatic vending machines for drinks and food, road tolls, sale of admission tickets, access control devices, public telecommunication services, internet, online services, pay-TV, etc. Furthermore, it is also known that chip-cards can be used purely as user identification means, for example in mobile radio telephones (SIM cards) or as admission tickets....

The present invention can however also be used with contactless user chip-cards or with other RFID (Radio Frequency Identification) elements, for example in watches, transponders, in mobile telephones equipped with a radio interface, in palmtops, etc. Similarly, the present invention can be used with components and devices containing a user identification and capable of connecting over a Bluetooth interface with external terminals, for example in order to perform transactions.

User chip-cards 4 can be inserted in the chip-card terminals 3 to perform transactions. According to the application and system, the chip-card 4 can for example consist of a value card in which electronic money units are stored, of a telephone card, for example a SIM (Subscriber Identification Module) or WIM (WAP Identification Module) card or of a telephone card for public telephone cells, of an admission card for secured systems or buildings, etc. User chip-cards are usually distributed to all authorized users of the terminals; at least certain transactions with the chip-card terminal can only be performed with a valid user chip-card.

Using the RFID card as a SIM card in a cellular telephone system places the card for use in an electronic device with a plurality of features. The SIM card adds features, like dialing out through a service provider, which improves the functionality of the cellular telephone.

In an analogous art, Jigour shows that memory cards used as SIM cards can include the manufacturer's logo. This is interpreted as a visual aid that is promotional in nature and therefore makes the memory card, at least part, a promotional material. The use of a manufacturer's logo helps the vendor sell more devices and helps the user keep track of the devices. Therefore, it would

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have been obvious to one of ordinary skill in the art at the time of the invention to have used a manufacturer's logo on the SIM card discussed above since such a logo would help identify the item for future sales.

2. Claims 11 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Legge, Lauper and Jigour as applied to claim 1 above, and further in view of Eberhart (6404339).

In an analogous art, Eberhart shows a transponder that uses a dipole antenna to provide capacitive coupling for transmitting data from a transponder to a reader. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used the dipole antenna and capacitive coupling of Eberhart in the above system in order to provide secure reading of the transponders.

3. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Legge, Lauper and Jigour as applied to claim 1 above, and further in view of Robinson (4591854).

In an analogous art, Robinson shows a communication device where the information is passed on via a contact interface, thus limiting the communication to very close range and providing secure access communication. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the

invention to have used the contact coupling of Robinson in the above system in order to provide secure reading of the transponders.

### ***Response to Arguments***

Applicant's argument with respect to the claimed promotional material limitation has been considered but is moot in view of the new ground(s) of rejection.

The applicant argues that Legg fails to teach having data on the transponder card that changes the way a game is played. This limitation is not present in the pending claims.

The applicant argues that the references fail to teach enhancing the operation of the electronic device. As proposed the teachings discussed above teach a wireless SIM card that provides operational information to the cell phone to allow the cell phone to use features of the phone. Depending on the particular SIM card and the particular services paid for that particular SIM card some enhanced features will provide by some particular SIM cards. Additionally, it would be noted that some portion (a reader) of the phone (in such a transponder SIM card embodiment) would be working at all times, and the addition of an authentic SIM card would provide the phone with improved phone function capabilities.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian A. Zimmerman whose telephone

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number is 571-272-3059. The examiner can normally be reached on Off every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Horabik can be reached on 571-272-3068. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Brian A Zimmerman  
Primary Examiner  
Art Unit 2635

BAZ